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APPLICATION NO.	TION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
07/676,690	•	03/28/1991	JO ANN M. CANICH	P-1733	7543		
23455	7590	02/01/2005 EXAMINER					
		HEMICAL CON	RABAGO, ROBERTO				
5200 BAYV P.O. BOX 2		VE		ART UNIT	PAPER NUMBER		
BAYTOWN	I, TX 77	7522-2149	1713				

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	<del> </del>							
		Appli	cation No.	Applicant(s)				
			76,690	CANICH, JO ANN	1 M.			
	Office Action Summary	Exam	niner	Art Unit				
		Robe	rto Rábago	1713				
Period f	The MAILING DATE of this communica or Reply	tion appears o	n the cover sheet with the c	correspondence ac	Idress			
THE - External control	IORTENED STATUTORY PERIOD FOR MAILING DATE OF THIS COMMUNICA consions of time may be available under the provisions of 3 in SIX (6) MONTHS from the mailing date of this community of a period for reply specified above is less than thirty (30) do period for reply specified above, the maximum statute under the provision of the pro	ATION. 17 CFR 1.136(a). In cation. ays, a reply within the ory period will apply a, by statute, cause the	no event, however, may a reply be tin e statutory minimum of thirty (30) day and will expire SIX (6) MONTHS from e application to become ABANDONE	nely filed s will be considered time the mailing date of this o D (35 U.S.C. § 133).	⅓y. :ommunication.			
Status								
1) 又	Responsive to communication(s) filed of	on 20 Decemb	er 2004.					
-	This action is <b>FINAL</b> . 2b)⊠ This action is non-final.							
3)								
	closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.							
Disposit	ion of Claims				·			
4)⊠	Claim(s) 34 and 37-42 is/are pending in	n the application	n.					
	4a) Of the above claim(s) is/are withdrawn from consideration.							
5)□	Claim(s) is/are allowed.		,					
6)⊠	Claim(s) 34 and 37-42 is/are rejected.							
7)	Claim(s) is/are objected to.							
8)[	Claim(s) are subject to restriction	n and/or electi	on requirement.					
Applicat	ion Papers							
9)[	The specification is objected to by the E	xaminer.						
·	The drawing(s) filed on is/are: a)		or b) objected to by the E	Examiner.				
,	Applicant may not request that any objection	-	•					
	Replacement drawing sheet(s) including the	_	•	` ,	FR 1.121(d).			
11)	The oath or declaration is objected to by				* *			
Priority (	under 35 U.S.C. § 119							
	Acknowledgment is made of a claim for All b) Some * c) None of:  1. Certified copies of the priority doc		ζ (,	-(d) or (f).				
	2. Certified copies of the priority doc			on No				
	3. Copies of the certified copies of the		• •		Stage			
	application from the International				-tage			
* \$	See the attached detailed Office action fo	•	` ''	d.				
Attachmen	• •							
	e of References Cited (PTO-892)	0.48\	4) Interview Summary	(PTO-413)				
	e of Draftsperson's Patent Drawing Review (PTO- nation Disclosure Statement(s) (PTO-1449 or PTC		Paper No(s)/Mail Da 5) Notice of Informal Pa		D-152)			
	r No(s)/Mail Date		6) Other:	, r	•			

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## **DETAILED ACTION**

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## Claim Rejections - 35 USC § 112

1. Claims 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37-42 are drawn to "catalyst system" yet the parent claim is drawn to "process for the polymerization." Therefore, it cannot be determined whether claims 37-42 are drawn to process or to catalyst.

## Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 34 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,227,440.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because substantially the same process is being claimed. The only differences between the two claims sets are: (a) the patented claims require a catalyst support, while the instant process is open-ended regarding a support, and (b) the patented claims may have the metallocene bridged or unbridged (y=0,1), while the instant claims are limited to unbridged species (y=0). However, since the instant claim clearly includes processes which have already been patented, it is not separately patentable.

- 4. Claims 37-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,057,475. Although the conflicting claims are not identical, they are not patentably distinct from each other because substantially the same catalyst is being claimed. The only differences between the two claims sets are: (a) the patented claims require a catalyst support, while the instant process is open-ended regarding a support, and (b) the patented claims may have the metallocene bridged or unbridged (y=0,1), while the instant claims are limited to unbridged species (y=0). However, since the instant claims clearly include catalysts which have already been patented, they are not separately patentable.
- 5. Claims 34 and 37-42 are directed to an invention not patentably distinct from claims 1-12 of commonly assigned 5,227,440 (for claim 34) and claims 1-18 of

commonly assigned 5,057,475 (for claims 37-42). The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 5,227,440 and 5,057,475, discussed above, would form the basis for rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Roberto Rábago Primary Examiner

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RR

January 31, 2005